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EXAMINER

DAVIS, CASSANDRA HOPE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL SHARON

Appeal 2007-3255
Application 10/755,161
Technology Center 3600

Decided: December 18, 2007

Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Sharon (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 11, 12, 14, and 15. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The Appellant's invention is directed to a compact disk pouch having an indexing tab and a series of such pouches resting in a carrier (Figs. 10 and 1). Claims 14 and 11, reproduced below, are representative of the subject matter on appeal.

14. A disk-shaped pouch, comprising:

a first disk-shaped side and a second side that are attached evenly to form a pouch for the containment and removal of an associated compact disk having a center hole,

said first disk-shaped side having at least one tab for including indicia in reference to said compact disk and extending beyond the periphery of said associated compact disk.

11. A rotational filing system for storing and retrieving a compact disk, comprising:

a plurality of disk-shaped pouches and

a means for support which rests on a horizontal surface,

¹ Our decision will refer to Appellant's Amended Appeal Brief ("App. Br.," filed Apr. 28, 2006) and the Examiner's Answer ("Answer," mailed Aug. 22, 2006).

wherein each disk-shaped pouch included in said plurality is adjacent to one another and rotates about a common axis of said support means,

each said disk-shaped pouch having at least one tab for including indicia in reference to said associated compact disk and extending beyond the periphery of said associated compact disk.

THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Kohn	1,295,763	Feb. 25, 1919
Reinhold ²	1,498,577	Jun. 24, 1924
Casey	2,917,179	Dec. 15, 1959
Kawachi	3,623,615	Nov. 30, 1971
Balzer	US 2003/0010815	Jan. 16, 2003

THE REJECTION

The following rejection is before us for review:

Claim 14 is rejected under 35 U.S.C. § 103(a) as unpatentable over Reinhold in view of Balzer.

Claim 15 is rejected under 35 U.S.C. § 103(a) as unpatentable over Reinhold in view of Balzer as applied to claim 14 further in view of Kohn.

² We note the Examiner omitted Reinhold in the Evidence Relied Upon section of the Answer. However, Reinhold is in each ground of rejection and the Appellant appears to have acknowledged the existence of Reinhold. As such, we consider this omission insignificant in deciding this appeal.

Claims 11 and 12 are rejected under 35 U.S.C. § 103(a) as unpatentable over Reinhold in view of Balzer as applied to claim 14 further in view of Kawachi or Casey.

ISSUE

The first issue is whether Appellant has shown that the Examiner erred in rejecting claim 14 under 35 U.S.C. § 103(a) as unpatentable over Reinhold and Balzer.³ This issue turns on whether there is a teaching, suggesting or motivation within the prior art to combine the references.

The second issue is whether the Appellant has shown that the Examiner erred in rejecting claim 11 under 35 U.S.C. § 103(a) as unpatentable over Reinhold and Balzer as applied to claim 14 further in view of Kawachi or Casey.⁴ This issue turns on whether the combination of the elements within the prior art achieves a predictable result.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

³ Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the Brief have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii) (2007).

⁴ See footnote 3.

1. Reinhold discloses in figures 1-6 a disk-shaped pouch 1-3 comprising a first disk-shaped side 1 and a second side 2, which are attached evenly to form a pouch for the containment and removal of a record. (Reinhold, figs. 1-3 and ll. 70-80.)
2. Balzer shows in the figures a tab placed on the top edge of a sleeve that can hold electronic media, e.g. CDs, DVDs, or the like. (Balzer, figs. 1-10 and ¶¶ 0002, 0047, and 0048.)
3. Balzer teaches that the tabs aid in archiving, indexing, referencing, and retrieving the desired sleeve and its contents therein. (Balzer, Abstract and ¶¶ 0002, 0029, and 0059.)
4. Kohn shows in the sole figure placing a hole 3 in a pouch in order to allow a portion of the article within the pouch to be seen. (Kohn, sole figure and ll. 80-85.)
5. Kawachi shows placing a plurality of disc-shaped cases in an elongated horizontal rack. As shown in figure 2, removal of a disc-shaped case from the rack is initiated by rotating the case around its central axis. (Kawachi, fig. 2 and col. 3, ll. 51-52.)
6. Casey shows placing a plurality of audio disks into a holder. (Casey, fig. 1.)

PRINCIPLES OF LAW

In *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the Supreme Court particularly emphasized “the need for caution in granting a patent

based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate this doctrine.” *Id.* (1) “In *United States v. Adams*, 383 U.S. 39, 50-51 (1966), ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* at 1740. (2) “In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 60-62 (1969) ... [t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation.” *Id.* (3) “[I]n *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976), the Court derived ... the conclusion that when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* The principles underlying these cases are instructive when the question is whether a patent application claiming the combination of elements of prior art would have been obvious. Thus, when considering obviousness of a combination of known elements, the operative question, as stated by the Supreme Court, is “whether the improvement is more than the predictable

use of prior art elements according to their established functions.” *Id.*

Although the Supreme Court rejected the rigid approach of the Court of Appeals for the Federal Circuit with respect to its application of its “teaching, suggestion, or motivation” test (TSM test), *id.* at 1739, the Court stated that “[t]here is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis,” *id.* at 1741. Thus, the TSM test is a rationale that can be used to support a conclusion of obviousness.

The Supreme Court admonished, “[a] factfinder should be aware, of course, of the distortion cause by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. *Id.* at 1742. However, the Court stated “[r]igid preventative rules that deny factfinders recourse to common sense ... are neither necessary under our case law nor consistent with it.” *Id.* at 1742-43.

As to the specific question of the prior art “teaching away,” our reviewing court in *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) stated:

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

ANALYSIS

The Appellant argues claims 11 and 12 as one group and claims 14 and 15 as another group. As such, we select claims 11 and 14 as the representative claims for each group and claims 12 and 15 stand or fall with the respective representative claims for each group. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Obviousness rejection of claims 14 and 15

The Examiner found that Reinhold describes the claimed structure of the disk shaped pouch, less the tab. (Answer, 4.) *See also* Finding of Fact 1. The Examiner found that Balzer discloses a tab on the top edge of a sleeve that can hold electronic media. (Answer, 4.) *See also* Finding of Fact 2. The Examiner concluded that “[i]n view of the teachings of Balzer it would have been obvious to one skilled in the art to modify Reinhold by placing a tab on the first disk-shaped side since this would allow a plurality of the pouches to be filed together and easily found based upon the indicia placed on the tab, i.e. stored and located in an easier, faster, and more convenient manner. (Answer, 4.) Balzer expressly teaches that the tabs can be used for archiving, indexing, referencing, and retrieving when the desired sleeve and its contents thereof are referenced and thus provides the motivation for modifying the Reinhold pouch so as to include tabs (See Finding of Fact 3).

Obviousness rejection of claims 11 and 12

The Examiner found that Kawachi and Casey each describe placing a series of pouches for circular media into a tray. (Answer, 6.) *See also*

Finding of Facts 5 and 6. In addition, the Examiner found that Kawachi discloses a plurality of reel cases rotatably mounted in the rack. (Answer, 6, 7 (grounds of rejection) and 8-9 (response to argument.)) *See also* Finding of Fact 5. The Examiner reasoned that it would have been obvious to combine the elements found in Reinhold and Balzer with the elements found in Kawachi or Casey in order to achieve the predictable result of “allow[ing] the pouches with audio devices therein to be stored in a more convenient and orderly manner.” (Answer, 6.) Further, with respect to these claims, the Examiner reasoned that the Kawachi and Casey holders “are capable of allowing disk-shaped pouches to perform the function of rotating about a common axis of the support means which is parallel to the horizontal surface.” (Answer, 6-7.)

We agree with the Examiner that applying the teachings of Kawachi or Casey to the Reinhold and Balzer combination yields the predictable result of providing an orderly and convenient manner of storing the articles taught by the Reinhold and Balzer combination.

Appellant’s contentions

We are not persuaded by Appellant’s argument that the Examiner has used hindsight reconstruction in making the rejection or that the references teach away from the claimed invention. (App. Br. 8-9.) In our view, there is ample motivation to provide the Reinhold pouch with a tab as taught by Balzer without resort to hindsight. In addition, there is nothing in any of the

Appeal 2007-3255
Application 10/755,161

references relied on by the Examiner that would discourage a person of ordinary skill in the art from providing a tab and central hole on the Reinhold pouch.

CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 11, 12, 14, and 15.

DECISION

The decision of the Examiner to reject claims 11, 12, 14, and 15 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

JRG

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